

REMARKS

In the Office Action¹, the Examiner rejected claims 1 and 30 under 35 U.S.C. § 112, first paragraph, rejected claims 1-7 under 35 U.S.C. § 112, second paragraph; objected to claims 1 and 30 for minor informalities, and rejected claims 1-7 and 30-33 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,198,915 to McGregor et al. ("*McGregor*") in view of U.S. Patent No. 6,347,136 to Horan ("*Horan*").

Applicants have amended claims 1-4, 6, 7, 30, and 32. The amendments are made in response to the Examiner's statements regarding the claim objections, the § 112 first paragraph rejection, and the § 112 second paragraph rejection in the Final Office Action. Applicants submit that the amendments do not change the scope of the claims and do not introduce new matter requiring a new search or consideration. Claims 1-43 are pending, and claims 8-29 and 34-43 have been withdrawn.

Regarding the rejection of claims 1 and 30 under 35 U.S.C. § 112, first paragraph, the Examiner states, "Applicants' amendment after 'function executing means' has a step critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure." The Examiner asserts that the "step that is missing is a step that follows the functions" (Office Action at page 2).

Although Applicants maintain that the claims do not omit any critical or essential step, Applicants have amended claim 1 to recite "operation inputting means for designating one of a plurality of functions, including playback, recording, fast forwarding,

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

and rewinding, designated by said operating inputting means.” Then, the “function executing means” may execute the designated functions. Applicants submit that the claimed “operation inputting means,” “function executing means,” measuring means,” and “computing means” are enabled by the specification and recite the critical or essential elements. Claim 30 has been similarly amended.

Therefore, Applicants respectfully request reconsideration and withdrawal of the rejection of claims 1 and 30 under 35 U.S.C. § 112, first paragraph.

Regarding the rejection of claims 1-7 under 35 U.S.C. §112, second paragraph, the Examiner states, “[t]here is no positive recitation as to the ‘chargeable amount’ in the recited step [and] it is not considered limiting” (Office Action at page 3). Although Applicants maintain that the claims, as filed, were not indefinite, in an effort to further prosecution, Applicants have amended claim 1-4, 6, and 7 to provide even greater clarity. Therefore, Applicants respectfully request reconsideration and withdrawal of the rejection of claims 1-7 under 35 U.S.C. § 112, second paragraph.

Regarding the objection to claims 1 and 30, Applicants have amended claim 1 to recite --for executing the functions-- and claim 30 to recite --each of the functions--, as suggested by the Examiner. Therefore, Applicants respectfully request that the Examiner withdraw the objection to claims 1 and 30.

Applicants respectfully traverse the rejection of claims 1-7 and 30-33 under 35 U.S.C. § 103(a). The prior art cited by the Examiner, *McGregor* and *Horan*, does not teach or suggest each and every element of claims 1-7 and 30-33. A *prima facie* case of obviousness has, therefore, not been established.

Claim 1 recites an electronic apparatus including, for example:

operation inputting means for designating one of a plurality of functions, including playback, recording, fast forwarding, and rewinding;
function executing means for executing functions designated by said operating inputting means;
measuring means for measuring the time during which each of said functions has been executed by said function executing means; and
computing means for computing an amount of charge based on the execution time measured by said measuring means regarding each of said functions.

(emphasis added). *McGregor* discloses mobile debit phone units “where real time calculation[s] of phone charges is necessary to limit phone use or to immediately bill for phone use” (col. 2, lines 27-30). A mobile phone unit 30 “can internally maintain a user’s call account, at least within a rental period or within a period of periodic polling by the central processing unit 14 during off hours” (col. 4, lines 46-50 and Fig. 1). Mobile phone unit 30, when functioning as a debit phone, can continue to operate until the account is exhausted (col. 4, lines 52-53).

The Examiner states that *McGregor* “failed to disclose function executing means for executing functions, including playback, recording, fast forwarding, and rewinding, designated by said operating inputting means” (Office Action at page 5). The Examiner cites *Horan* to disclose the claimed elements.

Horan discloses a caller identification method. Display/control logic 158 “includes control inputs (e.g. play, record, fast forward, rewind, pause, stop, keypad, arrows, etc.) for controlling answering machine functions, entering names and phone numbers, setting preferences, etc.” (col. 3, lines 52-55). These inputs are not used in computing charge based on an “execution time” of each input. *Horan* is silent regarding any type of charging means. Even though *Horan* discloses control inputs, these inputs are used for entering names, controlling an answering machine, etc. They are not used

by any “computing means for computing an amount of charge based on the execution time” of the control inputs.

In addition, the Examiner has not established the requisite motivation necessary to combine *McGregor* and *Horan*. The Federal Circuit has noted that “virtually all [inventions] are combinations of old elements.” *See e.g., In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457 (Fed. Cir. 1998) (internal citations omitted). The Federal Circuit has explained that an Examiner may find every element of a claimed invention in the prior art, but mere identification is not sufficient to negate patentability. *Id.* The court explained that “the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed.” *Id.*

Also, determinations of obviousness must be supported by evidence on the record. *See In re Zurko*, 258 F.3d 1379, 1386 (Fed. Cir. 2001), 59 USPQ2d 1693, 1696-98 (finding that the factual determinations central to the issue of patentability, including conclusions of obviousness by the Board, must be supported by “substantial evidence”). The desire to combine or modify references must be proved with “substantial evidence” that is a result of a “thorough and searching” factual inquiry. *See In re Lee*, 277 F.3d 1338, 1343-1344 (Fed. Cir. 2002), 61 USPQ2d 1430, 1433 (quoting *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351-52). Additionally, the Federal Circuit has clearly stated that the evidence of a motivation or suggestion to modify a reference must be “clear and particular.” *In re Dembicziak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

In this case, the Office Action does not show that a skilled artisan considering *McGregor* and *Horan*, and not having the benefit of Applicants' disclosure, would have been motivated to combine the references in a manner resulting in Applicants' claimed combination. The Examiner merely provided descriptions of how the references allegedly teach certain features without providing "clear and particular" reasons why a skilled artisan "would select the elements from the cited prior art references for combination in the manner claimed." See *In re Dembicziak*, 175 F.3d at 999, 50 USPQ2d at 1617; *In re Rouffet*, 149 F.3d at 1357, 47 USPQ2d at 1457.

The Examiner has alleged no motivation for combining *McGregor* and *Horan*, and no motivation exists. For example, *McGregor* calculates phone charge "to limit use or to immediately bill for phone use" (col. 2, lines 29-30). *McGregor* charges based on the duration and location of the phone call. One of ordinary skill would recognize that functions, such as playback, recording, fast forwarding, and rewinding are not associated with the phone charges in *McGregor*. Moreover, *McGregor* provides no motivation, explicit or implicit, for charging for functions other than talking for a duration of time.

In addition, *Horan* provides no teaching of computing charges. Any control input in *Horan* is used, for example, to listen to messages or organize an address book. Such actions are not associated with phone charges. The fact that both *McGregor* and *Horan* are related to telephone use does not provide the needed motivation to combine the two references.

For at least these reasons, the Examiner has not shown that one of ordinary skill in the art would have been motivated to combine *McGregor* and *Horan*, viewing only

teachings from within these references themselves, in a manner resulting in Applicants' claimed invention.

Accordingly, *McGregor* and *Horan* fail to establish a *prima facie* case of obviousness with respect to claim 1, at least because the references fail to teach each and every element of the claim. Claims 2-7 depend from claim 1 and are thus also allowable over *McGregor* in view of *Horan*, for at least the same reasons as claim 1.

Independent claims 30 and 32 and dependent claims 31 and 33, while of different scope, recite limitations similar to those of claim 1 and are thus allowable over *McGregor* in view of *Horan* for at least the same reasons discussed above in regard to claim 1.

Applicants respectfully request that this Amendment under 37 C.F.R. § 1.116 be entered by the Examiner, placing claims 1-7 and 30-33 in condition for allowance. This Amendment should allow for immediate action by the Examiner.

Furthermore, Applicants respectfully point out that the final action by the Examiner presented some new arguments as to the application of the art against Applicants' invention. It is respectfully submitted that the entering of the Amendment would allow the Applicants to reply to the final rejections and place the application in condition for allowance.

Finally, Applicants submit that the entry of the amendment would place the application in better form for appeal, should the Examiner dispute the patentability of the pending claims.

In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: December 18, 2006

By: /David W. Hill/
David W. Hill
Reg. No. 28,220